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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/774,652

02/06/2004

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EXAMINER

LUBIN, VALERIE

ART UNIT

PAPER NUMBER

3626

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/774,652	<b>Applicant(s)</b> JOHNSON, THOMAS D.	
	<b>Examiner</b> VALERIE LUBIN	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02/06/2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. Claims 1-29 are pending

For reference purposes, the document paper number is 20090126

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claims 1, 28, and 29 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. (Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); and Cochrane v. Deener, 94 U.S. 780,787-88 (1876), In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008)).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied. This

can be done, for example, by identifying the apparatus that accomplishes the method steps, by positively reciting the subject matter that is being transformed, or by identifying the material that is being changed to a different state.

Dependent claims 2-19, as dependents of claim 1, are rejected under the above analysis.

5. Claim 20 is directed to non-statutory subject matter such as “a plurality of predetermined medical consulting report quality criteria”

Claims 21-27, as dependents of claim 20, are rejected under the above analysis.

6. Claim 21 is directed to a human, which is non-statutory subject matter.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 20-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 20 is directed to a system comprising data, a reviewer and a system, but does not disclose any apparatus or device included in the system.

Claims 21-26 are rejected under the analysis of claim 20.

10. Claims 23, 24 and 26 are method claims, but depend on claim 20 which is a system claim. The scope of the claims is unclear, as they are directed to both a system and method steps.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-5, 14, 16, 20-22, 25, 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Joffe et al. Pre-Grant Pub No. 2003/0233250.

13. With respect to claim 1, Joffe teaches a method comprising the steps of assessing the quality of each said medical consulting report with respect to predetermined criteria to generate quantified medical consulting report quality data (Fig. 2; ¶ 12, 58); and statistically

analyzing said medical consulting report quality data to generate aggregate medical consulting report quality data (§§ 56, 73).

Claim 20 is rejected, under the above analysis, as Joffe recites a system to perform the method of claim 1 based on a plurality of criteria (§§ 56, 58, 73, 131).

Claims 21 and 22 are also rejected under the above analysis.

14. Claim 2 is rejected as Joffe recites a report format as a criterion (§§ 75).

15. Claim 3 is rejected, as Joffe recites criteria including the relevance of the report to the medical questions addressed (§§ 139).

16. Claim 4 is rejected, as Joffe recites criteria including support in the report for the conclusion reached (§§ 214, 228).

17. Claim 5 is rejected, as Joffe discloses medical-legal terminology (Fig. 10B).

18. Claims 14 and 16 are rejected, as Joffe recites reporting aggregate data in tabular and graphic formats (Fig. 10A, B).

19. Claim 25 is rejected, as Joffe teaches a reporting system (Fig. 3 elements 308, 338, 340, 342).

Claim 26 is rejected under the analysis of claim 25.

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 6-13, 15, 17-19, 23, 24, 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joffe et al. Pre-Grant Pub No. 2003/0233250.

18. For claim 6, Joffe recites the scoring of data and criteria (§ 127-129, 131). He does not specifically recite scoring the criteria according to an objective scoring scale unique to that predetermined criterion; however the scoring scale used is merely a substitution of one scoring technique for another that yields the predictable result of assigning a score to data or criteria (Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)).

22. For claim 7, Joffe recites a cumulative score for data representative of an assessment (§ 128, 131). He does not specifically recite a point total with respect to a predetermined criterion; however, it would have been obvious to one of ordinary skill in the art to apply the point total of Joffe to any kind of relevant data, including the predetermined criteria for the assessment in order to evaluate the importance of each criterion.

Claim 9 is rejected under the analysis of claim 7.

23. With regards to claim 8, Joffe does not specifically recite a point total range of 0-5; however Examiner takes Official Notice that score ranges were old and well known in the art at the time the invention was made. It would therefore, have been obvious to one of ordinary skill in the art to use a score range or scale in order to impose a minimum and a maximum limit on scores.

24. For claim 10, Joffe discloses scoring data according to predetermined criteria (§ 131). He does not specifically recite generating an average score; however, Examiner takes Official Notice that such a method was old and well in the art at the time the invention was made. It would have been obvious to one of ordinary skill in the art to combine the prior art in order to compare average scores of criteria.

25. Claim 11 is rejected, as Joffe recites applying a weight to data elements (§ 129).

26. For claim 12, Examiner takes Official Notice that generating weighted average scores was old and well known in the art at the time the invention was made. It would have been obvious to one of ordinary skill in the art to combine the prior art in order to compare average scores of criteria.

27. For claim 13, Joffe recites a cumulative score for data representative of an assessment (§ 128, 131). He does not specifically recite summing weighted average score for each criterion; however, it would have been have been obvious to one of ordinary skill in the art to apply the cumulative scoring of Joffe to weighted scores also, including the predetermined criteria for the assessment in order to evaluate the importance of criteria.



Claims 23 and 24 are rejected under the analysis of claim 13.

28. With respect to claim 15, Joffe discloses reporting data (Fig. 1, element 145) from a plurality of sources (Fig. 2). He does not disclose reporting data for each of the sources, but it would have been obvious to one of ordinary skill in the art to generate reports on single source or combined sources in order to compare the quality and conclusion of the two types of reports.

29. For claim 17, Examiner takes Official Notice that generating distribution curves for data was old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to construct a distribution curve for the different reports as data elements in order to graphically compare the reports scores.

30. For claim 18, Examiner takes Official Notice that deleting data prior to reporting was old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to include deleting means in order to facilitate data management.

31. Regarding claim 19, first, the step of communicating with a party is optional, and it has been held that, "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II.C). Second, the steps of communicating and documenting said communication were both old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill to combine

the prior art to document communications with parties involved in the method in order to have records for future reference.

32. Regarding claim 27, Examiner takes Official Notice that a system for selecting professionals was old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill to combine the prior art to in order to select professionals that meet certain criteria.

33. With respect to claim 28, Joffe teaches a method comprising the steps of receiving an initial medical report from the medical professional (§ 73, 79); and assessing the quality of a medical report with respect to predetermined criteria (§ 58). The language, “to determine the sufficiency of said ...” is the intended use of the step of assessing, which does not further limit the step of assessing the quality of the data (In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)).

The limitation of “requesting additional information...” along with subsequent limitations are optional and, “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation” (MPEP 2106.II.C). Thus, the last five limitations of claim 28 do not further limit the method of the claim. Furthermore, the repetition of the receiving, assessing and statistically analyzing steps is a mere duplication of steps, and it has been held that, “mere duplication of parts has no patentable significance unless a new and unexpected result is produced” (In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)).

The limitation of documenting communications was both old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary

skill to combine the prior art to document communications with parties involved in the method in order to have records for future reference.

34. With respect to claim 29, Joffe teaches a method comprising the steps of assessing the quality of each said medical consulting report with respect to predetermined criteria to generate quantified medical consulting report quality data (Fig. 2; ¶ 12, 58); and statistically analyzing said medical consulting report quality data to generate aggregate medical consulting report quality data (¶ 56, 73). Joffe also discloses, receiving a report from medical professionals (Fig. 2, ¶ 79). A predictable result of Joffe would be to obtain a body of research from professionals that meet certain quality criteria to ensure the credibility and integrity of data obtained (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

### ***Conclusion***

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Loble et al. U.S. Patent No. 5,844,817 and Brzozowski U.S. Patent No. 6,842,736 recite certain of Applicant's scoring limitations and claims.
- b) Hudy, U.S. Patent No. 6,594,668 discloses generating a distribution curve for data.
- c) Ross, Jr. et al. U.S. Patent No. 5,823,948 recites communicating and documenting communications with other parties.

d)      Goldenberg, Pre-Grant Pub No. 2002/0065682, discloses a system for selecting medical professionals.

36.      Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

        Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VL

/C Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626